

Appl. No. 10/701,873

Amdt. Dated 11/29/2005 Reply to Office action of 09/06/2005

#### **AMENDMENTS TO THE DRAWINGS**

The attached sheet of drawing includes the addition of a new figure, FIG 4. This sheet of drawings also includes replacement sheets for FIG 1-3, which replace the corresponding sheets for the previous amendment and are identical to those in the original application so that there is no new matter introduced in the drawings.

Attachment: Three(3) replacement sheets and one sheet containing a new figure.

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#### REMARKS/ARGUMENTS

The amendment filed August 17, 2005 is objected to by the examiner under 35 U.S.C. 132(a) because it introduces new matter specifically the mention of a snap apart connection. Applicant must respectfully disagree. In the original application in the paragraph ending on the top of page 15, the last sentence reads: "As an option the punch could be manufactured with a snap apart lower portion 580 or with that lower portion 580 fixed to the housing 550." This paragraph was amended in the first amendment dated 16 December 2004 where the last sentence reads: "As an option the punch could be manufactured with a snap apart lower portion 580 or with that lower portion 580 fixed to the housing 550." That paragraph was again amended in the RCE dated 3 August 2005 and converted into two (2) paragraphs. The last sentence of the second paragraph now reads: "As an option the machine 500 could be manufactured with a snap apart bottom portion 580 where that portion 580 could be removed from the machine 500 after the sheet of material has been processed to aid in the removal of that sheet of material from the machine 500." Clearly there has been no new material introduced into this application and the applicant respectfully requests that the examiner withdraw the objection to the specification.

Claims 1,2,5,9,11,12,16,17,20,23,25, and 26 are rejected under U.S.C. 112, first paragraph again because of alleged new matter. Based on the argument and information in the above, there is no new matter introduced with the application based on the concept of a snap apart lower portion of the invention. Again the applicant respectfully requests that the examiner withdraw the objection to the above claims.

Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Farmwald et al (2,816,608). Claim 30 as currently amended refers to an adjustable apparatus 530 that is attached to a housing 550 of a hand-held punch where such housing contains as a minimum the cutting die in its upper position prior to punching. Clearly Farmwald et al does not have such a housing as well illustrated in both FIG 1 and FIG 3 of Farmwald et al. Additionally, the adjustable part of the apparatus in Farmwald et al is an internally

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threaded piece of hardware like a nut while the adjustable part of the invention is limited within claim 30 to an externally threaded piece of hardware such as a screw. Clearly there are significant differences between these two types of hardware.

The adjustable apparatus of Farmwald et al is clearly incorporated into the frame and the operating portion of the tool and such adjustable apparatus could not be easily added to a tool similar to the one in Farmwald et al without a major disassembly of that tool. Claim 30 of the invention describes an adjustable apparatus that can be easily added to existing punches without any disassembly of that punch. As FIG 3 of the application shows, the adjustable apparatus of claim 30 is a separately manufactured item, which is then added to a separately manufactured punch.

Claims 1,2,5,9,10,11,12,16,17,20,23,25,26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (5,749,278) in view of Snow (132,544)

Lee et al disclose only a lever-actuated punch for piercing material. The invention only claims that type of machine in claims 9 and 23 of the application. As the examiner acknowledges Lee et al does not disclose an adjustable apparatus that controls the vertical motion of a punch thereby limiting the amount of a punch pattern punched into a sheet of material. Snow discloses a cutting machine with an adjustable apparatus not a punching machine. The invention of Snow controls the length of a cut made by a scissor-type arrangement, not the pattern pierced by a punch. Snow must start at the edge of the sheet of material while a punch by its nature makes a closed geometry pattern somewhere within the sheet of material, not starting at the edge. Claim 3 of Snow states: "In combination with a pair of cutters, one or both of which has its cutting-face curved, so that the length of the cut made thereby may be varied by varying the travel of the moveable die, I claim an adjustable stop to limit the movement of the moveable die, substantially as described." Snow is varying the "length of the cut" made by a pair of cutters, not the depth of a cut made by a single cutting die of a punch. Note that Snow talks of cutting slits of varying length in a piece of paper. There is no disclosure in Snow of a punch with a closed geometry. As the examiner has noted several patents: McWilliams (143,023), Stimpson (678,781) and Pace (1,806,704) all disclose cutting machines with an adjustable apparatus. The key to the invention is an adjustable

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apparatus that controls vertical motion and is used solely in conjunction with hand-held machines as claimed in the newly amended claims. All of the prior art including Snow refer to and disclose bench-top industrial tools used for high volume production, none are related to arts and crafts usage. Lee et al discloses a lever-actuated punch, but as noted by the examiner Lee et al does not disclose an adjustable apparatus. It is not obvious to combine an industrial tool adjustable apparatus based on slitting or cutting from the edge of the sheet of material as disclosed in Snow with a punch such as disclosed in Lee et al where that punch is used away from the edge of the sheet of material. The key parameter for Snow is the length of the cut while the key parameter for the punch with the invention is the depth of the cut or the amount of the punch pattern pierced into the sheet of material.

Claims 30 and 31 (withdrawn, currently amended) are the most different from Lee et al in view of Snow. These claims show a separately manufactured item that is attached either permanently or temporarily to a punch similar to that of Lee et al to add an adjustable feature to such previously manufactured punches. These two (2) claims show that such an adjustable feature is attached to the housing of the punch, which is another feature, not disclosed by Snow. In fact, Snow could not function with a housing, which would interfere with the feeding of the paper strip, which is the only type of material that Snow can handle. The adjustable apparatus of claims 30 and 31 of the application are most like an adjustable shim acting as an adjustable stop. Prior art shows no such type of adjustable shim.

Claims 11, 12, 25 and 26 of the invention as amended similarly claim a housing for the invention, which is not a part of Snow and as discussed above could not function as a part of Snow.

We have added an additional drawing (FIG 4) to this amendment along with new paragraphs in the amended specification describing FIG 4. This is not new matter since FIG 4 serves only to clarify the key element of the invention and is also shown in the referenced prior art of United States Patent 5,749,278.